

REMARKS

In the Office Action mailed from the United States Patent and Trademark Office on September 18, 2006, the Examiner rejected all claims under 35 U.S.C. § 103(a) as being unpatentable: claims 1-16 and 18-23 over U.S. Patent No. 5,295,064 to Malec (hereinafter “Malec”) in view of U.S. Patent No. 5,250,789 to Johnsen (hereinafter “Johnsen”) and claim 17 over Malec in view of Johnsen in further view of U.S. Patent No. 5,283,550 to MacIntyre (hereinafter “MacIntyre”). Applicants respectfully traverse.

Rejections under 35 U.S.C. § 103(a):

In the Office action, the Examiner rejected all claims citing at least the combination of Malec and Johnsen. The standard for a Section 103 rejection is set forth in M.P.E.P 706.02(j), which provides:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Applicants respectfully submit that the references cited by the Examiner do not teach or suggest all the limitations claimed in the claim set provided herein. Applicants also respectfully submit that there is no suggestion or motivation to combine the references in the manner suggested by the Examiner, and that one of skill in the art would not reasonably expect success in combining the references in the manner provided.

Failure of the Cited Art to Teach All Claim Limitations:

Specifically, independent claim 1 has been amended and now provides for a shopping cart display system comprising “one or more transceiver units for sending information to the display unit, said transceiver units located proximate to promoted items, wherein the information includes product-specific promotions; a transmitter for sending information to the transceiver unit in direct electronic communication with the transceiver unit; . . . and a computer for operating the interaction between the display unit, the transceiver units, and the transmitter in direct electronic communication with the transmitter unit and in indirect electronic communication with the transceiver unit through the transmitter.” These combinations of elements are not disclosed in the cited references.

Specifically, Malec teaches a shopping cart display system but does not disclose transceiver units in direct electronic communication with a transmitter and a computer that operates the interactions between the various units. In the Office Action, the Examiner posits that Malec teaches transceiver units through its teaching of the trigger transmitters, indicating that the transmitters “achieve the same result” as the transceivers claimed. Applicants respectfully disagree and have amended the claim to more particularly point out the distinctive features of Applicants’ invention. Specifically, claim 1 now requires that the transceivers be in direct electronic communication with a transmitter sending information from the controlling computer and further requires that the transceivers send product-specific promotions to the display units. These limitations are not taught or suggested by Malec.

The trigger transmitters of Malec serve a completely different function from the transceivers claimed. Malec’s trigger transmitters do not transmit any product-specific information for the user, but merely transmit location information; the display then searches in

its memory for messages related to that location information for display. (Col 8 lines 41-60)

Thus, the trigger transmitters only serve as location beacons serving as signposts to tell the shoppers “You are here.” (Col 2 lines 29-36) Because the trigger transmitters only transmit location information which is not subject to changes, they do not need to receive any additional information to function, and thus do not have receivers and are not in direct communication with the centralized computer system or with any other transmitters. In fact, if a trigger transmitter location changes, Malec specifically discloses that the location is to be entered by store personnel in the centralized database of locations. (Col 7 lines 54-57)

In contrast, the transceivers claimed serve a function of transmitting product-specific promotions and advertisements for display on the display unit. By definition, this information is more complex and as described in the specification as filed is subject to change. Therefore, the claimed transceivers are designed to be able to receive additional information to update the product-specific information to be transmitted, and are thus in communication with the controlling computer and transmitter. Applicants respectfully note that the trigger transmitters of Malec fail to achieve the same result as the claimed transceivers because they fail to allow for updated information to be transmitted from the control computer to the transceiver units and then from the transceiver units to the display units. This result is only achieved by Applicants’ claimed invention because the transceiver units are in direct electronic communication with the computer through the transmitter as claimed.

Malec is very specific about how the information is provided to the shopping cart displays (SCDs). “All data required for SCD system operation is sent storewide by the ISC 502 to the SCD electronics 514 present on each of the carts 500 by a Store Message Transceiver (SMT) 503.” (Col 8 lines 28-31) In the Office Action, the Examiner relied on items 503, 500,

513 and 514 as disclosing the claimed transceiver units. Applicants respectfully note that item 602 relied on earlier in the rejection is merely a sub-element of item 503, and is therefore not located proximate to promoted items, as is required in the claims. (See Col 9 line 60-Col 10 line 1.) Item 513 is a trigger transmission (not a physical item, but an electromagnetic emission), and therefore cannot be a transceiver as claimed. (Col 8 line 53) Item 500 is merely a shopping cart, and is therefore not a transceiver located proximate the promoted items as claimed. (Col 8 line 30) Finally, item 514 is not a transceiver but is the “cart-mounted electronics” that is part of the SCD display unit, and is therefore not proximate the promoted items as claimed. (Col 8 line 52) Therefore, none of the items cited by the Examiner are a transceiver as claimed in claim 1 and Applicants therefore respectfully submit that Malec does not teach all the limitations of claim 1.

Johnsen also does not teach transceiver units proximate the promoted items and in electronic communication with the controlling computer by a transmitter. Johnsen specifically discloses using a handheld scanner to scan product barcodes. (Col 4 line 67-Col 5 line 1, Col 6 lines 40-42) Johnsen teaches that the scanned information is used to show coupons and other product information based on a downloaded database stored on memory of the display. (Col 6 lines 42-45) Because the system is entirely manually controlled based on the user’s scanning an item or not, never is it disclosed that information is received from transceivers proximate the products. Therefore Johnsen also fails to teach the claimed limitations.

**Lack of Motivation to Combine References Drawn from the References Themselves:**

Applicants note that the Examiner appears to have ignored Applicants’ previous remarks regarding the lack of a motivation to combine Malec and Johnsen in the manner suggested by the Examiner. Specifically, Applicants note that the Examiner has made no reply to Applicants’

arguments in this regard. Applicants respectfully request that the Examiner consider and address Applicants' remarks as follows:

Even if either Malec or Johnsen is misinterpreted to teach all the claim limitations, Applicants respectfully submit that there is no motivation to combine Malec and Johnsen to arrive at the claimed invention, and that one of skill in the art would not expect success in doing so. Malec and Johnson are aimed at solving fundamentally different problems and use completely different mechanisms to achieve their respective solutions. Malec is aimed at providing advertising before a product is selected in an attempt to encourage impulse buying of the advertised products by directing advertisements at the physical location of the person in the store. (Col 1 lines 45-57) In contrast, Johnsen is aimed at assisting customers in saving money by organizing coupons and also at providing advertising related to items the customer has already selected. (Col 4 lines 40-49) These two systems do not provide benefits to one another, and one of skill in the art would not be motivated to combine them and would not expect success in doing so. As Malec indicated, advertising that comes after an item has been selected comes too late to influence purchasing decisions as is desired by Malec's system. (Col 1 lines 17-24) Similarly, advertising of items in which the consumer is not interested and for which the consumer does not have needs or coupons does not improve the post-selection information provided by Johnsen and would merely distract the user from the desired products. (Col 5 lines 13-15)

In the Office Action, the Examiner indicated that one of skill in the art would have been motivated to combine Malec and Johnsen in order to eliminate the need for memory on the cart. However, the Examiner did not cite to any portion of Malec or Johnson that provides this supposed motivation. What the Examiner has apparently failed to recognize is that **both** the

systems of Malec and Johnsen require large amounts of memory on the cart because neither system discloses receiving advertising information through transceivers. As discussed above, the trigger transmitters of Malec do not save any memory needs on the cart since they only transmit location information and the cart system looks up on its internal database for the related advertising information. (Col 8 lines 52-58)

Similarly, the scanner systems of Johnsen require a large amount of memory on the cart since the cart may have the entire store database of items on it in addition to advertising materials and coupons to be able to react to any scanned item. (Col 6 lines 42-56) In fact, it appears that the system of Johnsen requires more memory on the cart than does Malec since the entire store database must be loaded on the cart (Col 6 lines 42-45), and thus one of skill in the art would not expect successful memory savings by adding any elements of Johnsen to Malec. As for making the shopping experience more delightful for the user, Applicants are unsure as to how the Examiner believes that Johnsen's system somehow adds delight to Malec's system, and nothing in either reference explains such delight.

Applicants respectfully submit that there must be some suggestion or motivation either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify or combine what the reference teaches. Malec and Johnsen simply fail to suggest the combination of the prior art references suggested by the Examiner. "Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." *In re John R. Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992). Any such suggestion must be "found in the prior art, and not based on applicant's disclosure." *In re Vaeck*, 947 F.2d at 493. Indeed, "[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification

obvious unless the prior art suggested the desirability of the modification.” *In re Mills*, 916 F.2d 680, 682 (Fed. Cir. 1990). A “clear and particular” showing of the suggestion to combine is required to support an obviousness rejection under Section 103. MPEP § 2142.

In essence, Applicants urge that the proposed combination of the listed references is not a product of a suggestion contained within them, but a product of inappropriate hindsight analysis. “Hindsight reconstruction” cannot be used “to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.” *Ecolochem, Inc. v. S. California Edison Co.*, 227 F.3d 1361, 1371 (Fed. Cir. 2000) (quoting *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988)). Rather, “the best defense against hindsight-based obviousness analysis is the rigorous application of the requirement for a showing of a teaching or motivation to combine the prior art references.” *Id.* “Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor’s disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.” *Id.* (quoting *In re Dembiczak*, 175 F.3d 994 (Fed. Cir. 1999)).

In light of the absence of any suggestion or motivation to combine the above-referenced prior art, the mere fact that such prior art could be combined in a manner suggested by the Examiner does not render the presently-claimed invention obvious.

Therefore Applicants respectfully submit that the cited references, alone or in combination, fail to teach all claim limitations of independent claim 1, that one of skill in the art would not be motivated to combine the references as indicated, and that one of skill in the art would not expect success in doing so to arrive at the claimed invention. For all these reasons, Applicants respectfully submit that claim 1 is not made obvious by the cited combination of

references and therefore respectfully request removal of the rejection. Claims 2-23 depend from claim 1 and are allowable for at least the same reasons. Applicants therefore respectfully request removal of all remaining rejections.



CONCLUSION

Applicants submit that the amendments made herein do not add new matter and that the claims are now in condition for allowance. Accordingly, Applicants request favorable reconsideration. If the Examiner has any questions or concerns regarding this communication, the Examiner is invited to call the undersigned.

DATED this 15 day of December, 2006.

Respectfully submitted,



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